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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/640,852

08/14/2003

Michael Sheinson

1175-R-01

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7590

07/06/2005

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
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EXAMINER

FISHER, MICHAEL J

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/640,852

Applicant(s)

SHEINSON ET AL.

Examiner

Michael J. Fisher

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/5/04 11/30/04
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: DECLARATION

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 and 24-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no technological innovation in the claims. Specifically, the limitations could be met merely with discussion.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5,7,8,10-18, 20,21 and 24-30 are rejected under 35 U.S.C. 102(b) as being anticipated by the Declaration of Michael J. Fisher (Fisher).

As to claims 1 and 24, Fisher discloses a method for generating a lead including receiving vehicle identifying information (Honda), receiving seller identifying information (the dealership), independently determining the estimated value using one or more buyer specified criteria (Honda for around \$X,000), and presenting said value to the seller (tell the boss that you will sell the car for \$X,000), transmitting seller identifying information to the buyer (call the customer to come in because there's a suitable Honda available).

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As to claim 14, Fisher discloses the automobiles as being traded in for \$1,000-\$1,500 (which price depends on the automobile's condition) and refining the value using buyer criteria (around \$X,000).

As to claims 2,15 and 25, the buyer criteria is make or "vehicle specific criteria" (Honda) and a price control option (for \$X,000).

As to claims 3 and 26, vehicle identifying information includes make (Honda) and condition (nice enough to be worth \$3,000-5,000).

As to claim 4, historical data is used in that older Hondas generally are known to be more reliable than the average automobile.

As to claim 5, Fisher discloses an appraisal report.

As to claim 7, Fisher discloses giving the price as a range.

As to claims 8 and 18, Fisher teaches the prices as being above wholesale (from the Sterling example) to a percentage above (any amount over is a percentage over).

As to claims 10,20 and 29, Fisher discloses including sales tax in the price.

As to claims 11 and 21, Fisher discloses having a list of potential buyers.

As to claims 12,16,17 and 27, it is inherent that vehicle condition, physical and mechanical, is considered when appraising an automobile. Poor condition would make an automobile worth less.

As to claim 13, Fisher discloses contacting people using their names and phone numbers.

As to claim 28, Fisher discloses sending the information to the potential buyer.

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As to claim 30, vehicle condition information inherently includes physical and mechanical condition flaws.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6,9,19 and 22,23 and 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher.

Fisher discloses a method as discussed above.

As to claim 6, Fisher does not teach a "demand certificate". It would have been obvious to one of ordinary skill in the art to provide a "demand certificate" to the customer so they could receive the information via fax or mail in case the salesman does not have their phone number.

As to claims 9 and 19, Fisher does not teach the range as being between about 8 to 10 percent. It would have been obvious to make the increase between 8 and 10 percent according to desired profit margin.

As to claims 22,23,37 and 38, Fisher does not teach an apparatus for accomplishing the method. It is very well settled in case law (In re Venner and Bowser, 120 USPQ 192 (CCPA 1958)) to automate a known process. Therefore, it would have been obvious to one of ordinary skill in the art to use a computer, with processor and user interface, to automate the method as taught by Fisher by automating it to ensure that the notices of available automobiles is received by potential customers quickly and accurately.

As to claims 31 and 39, Fisher does not specifically mention a second vehicle. However, Fisher does disclose trying to find a vehicle according to the customer's criteria. Therefore, it would have been obvious to one of ordinary skill in the art for the salesman to transmit the information about a second vehicle if it meets the customer's criteria.

As to claim 32, Fisher discloses using buyer criteria to determine the value.

As to claim 33, Fisher discloses the buyer criteria to be vehicle specific criteria (Honda).

As to claim 34, vehicle information inherently includes make, model, vehicle identification number, year and the vehicle's condition inherently affects value.

As to claim 35, the salesman would tell the manager (seller) the price given to the customer.

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As to claim 36, the third party is the customer.

As to claim 40, Fisher discloses sending the estimated value to the third party (the customer).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PAT 5,493,490 to Johnson discloses an electronic system for selling automobiles using vehicle and customer provided criteria.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF
6/27/05


DEANT NGUYEN
PRIMARY EXAMINER